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| SERIAL NUMBER | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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08/070,455 06/09/93 HOFVANDER

0 0033012-03
EXAMINER

FOX, D

1SM2/1280

BENTON S. DUFFETT, JR.
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1804

DATE MAILED:

12/30/93

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

for restriction purposes only

This application has been examined Responsive to communication filed on _____ This action is made final.

A shortened statutory period for response to this action is set to expire _____ month(s), 30 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892.
2. Notice re Patent Drawing, PTO-948.
3. Notice of Art Cited by Applicant, PTO-1449.
4. Notice of Informal Patent Application, Form PTO-152.
5. Information on How to Effect Drawing Changes, PTO-1474.
6. _____

Part II SUMMARY OF ACTION

1. Claims 1-20 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. Claims _____ have been cancelled.

3. Claims _____ are allowed.

4. Claims _____ are rejected.

5. Claims _____ are objected to.

6. Claims 1-20 are subject to restriction or election requirement.

7. This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. Formal drawings are required in response to this Office action.

9. The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are acceptable. not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10. The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been approved by the examiner. disapproved by the examiner (see explanation).

11. The proposed drawing correction, filed on _____, has been approved. disapproved (see explanation).

12. Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has been received not been received been filed in parent application, serial no. _____; filed on _____

13. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. Other

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EXAMINER'S ACTION

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1 and 4-20, drawn to a GBSS gene, vectors, plant cells and plants containing the gene, and a method of introducing the gene into plant cells, classified in Class 435, subclass 172.3, for example.

II. Claims 2-3, drawn to starch, classified in Class 426, subclass 549, for example.

The inventions are distinct, each from the other because of the following reasons:

Each of the Groups involve special technical features not required by the other group. The invention of Group I involves the special technical features of genetic engineering, gene isolation, gene introduction, and plant tissue culture techniques not required by the invention of Group II (since the invention of Group II can be made by a materially different process such as the isolation of starch from a mutant plant containing amylose-free starch, or by chemically treating wild type starch). Furthermore, the invention of Group II involves the special technical feature of starch isolation, purification, and derivation not required by the invention of Group I.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their divergent subject matter and fields of search, as evidenced

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by their divergent classification, restriction for examination purposes as indicated is proper.

A telephone call was made to Benton S. Duffett, Jr. on 29 December 1993 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fox whose telephone number is (703) 308-0280.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

December 29, 1993

DAVID T. FOX
PRIMARY EXAMINER
GROUP 180

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Decided 12/29/93